

## **REMARKS**

### **Claim Rejections**

Claims 1-3, 5-12, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sidana (U.S. 6,571,295 B1) in view of Boys (U.S. 6,516,340 B2).

### **Drawings**

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

### **Claims**

Applicant submits that claims 1-3, 5-12, and 14 are distinguishable over the cited prior art, whether taken individually or in combination.

As per claims 1 and 8, Sidana states in column 11, Claim 11:

means accompanying the browser in the computer system for web page annotations . . . storing the annotations at a location remote from the local browser ....

The Applicant interprets the statement provided above to mean adding, editing, deleting or storing annotations all taking place on the remote website. Also, Sidana teaches, column 1, line 66 through column 2, line 5 using a software program called a 'redirector' to allow a user to store custom information in conjunction with Web documents. In a preferred embodiment, the custom information includes annotations made by a user to a Web document. In this embodiment, the browser software sends an HTTP request to the redirector, which sends back an HTML 'form' to the browser. Sidana states column 2 lines 10-11:

The browser then sends (submits) the information from the form to the redirector.

Therefore, in Sidana, "the remote website" is equivalent to the "redirector".

In column 2, lines 17-28 of Sidana states:

If the user previously had made any annotations or had added any other custom information to the Web document, the annotations and/or other custom information were stored in the redirector at that time. The redirector modifies the HTML of the requested document to include any previously added annotations, if the user wants such annotations displayed. The redirector also modifies the HTML so that various input forms for allowing user input (such as 'buttons', text boxes, etc.) will be displayed by the browser. The HTML for the document, the HTML for the input forms, and the HTML for the annotations are collectively termed "augmented HTML". The augmented HTML is then sent to the browser ....

Thus the annotating tool is transmitted to a user in HTML form to which the user adds his annotations. This user-edited content will not change the source code of the web page. Instead, this content will be transmitted to the redirector by HTML form. Receiving this user-edited content, the redirector will modify its previous HTML to an augmented HTML version, and then transmit it to the user browser in which the content is displayed. In other words, Sidana asks the user to add annotations to the web page. With the newly-added content, Sidana modifies its previous HTML to an augmented HTML, which is then transmitted and displayed to the user. Therefore, the approach of Sidana is not capable of displaying the annotations instantly on the web page. The displayed content, which Sidana stated in Figure 7, and Column 7, lines 13-41, means the augmented HTML transmitted from the redirector.

The present invention is quite different from the above-mentioned approach of Sidana. Unlike Sidana, the present invention, features "providing a plurality of reading record functions on the web page." (See Claim 1) The so-called "reading record functions" are provided by the programs on the web page and thus can instantly display the reading records on the web page without modifying HTML via the redirector.

The secondary reference to Boys states, column 5, lines 12-14:

Software 35 allows lecturer 17 to search for access, and cache copies of WEB pages related to any desired subject matter upon which he or she wishes to base a lecture.

Further Boys states, column 6, lines 17-19:

However, once software 35 of FIG. 1 is invoked, a unique tool bar 43 appears in a convenient location ....

Therefore, bar 43 belongs to Software 35. In column 6, lines 34-36, Boys states:

A button labeled Text is provided and adapted to allow a lecturer to insert text wording into any place on a cached WEB page ....

As stated above, it is quite obvious that "A button labeled Text" is part of bar 43.

To sum up, a lecturer can insert words to a cached web page, and this can be achieved by downloading a cached copies of web page using FrontPage.

The "reading record functions" of the present invention is provided by the programs on the web page and allows the user to annotate the displayed content on the browser without installing any software like Software 35 on the user side.

In column 8, lines 23-25, Boys states:

In this way, the lecturer may conduct a lecture without necessarily editing the WEB pages. Simple text instruction appearing in recipients chat windows would direct recipients to which portions of a lecture page to pay attention ....

In Boys, the content displayed in the recipient chat window is not the "annotations". Rather, the content is a reminder to the user.

The approach taken by Sidana requires the user to transmit the annotated content to the redirector which will modify the previous HTML to augmented HTML and transmit the augmented HTML to the user and display it on the browser. The approach taken by Boys requires the user to install Software 35 in order to download

a cached web page on which the user can edit. The two approaches don't allow the user to edit the content directly on the web page. The approach of the present invention allows the user to edit the content on the web page directly on the browser without installing any software first. Therefore the approaches taken by Sidana and Boys combined cannot provide the same function as ours.

As per claims 2 and 9, the annotative tool provided by Sidana modifies HTML 184 to augmented HTML within Redirector 172 (see fig 5). The augmented HTML will then be transmitted to Browser 170 and the annotated content will be displayed. Whereas the present invention allows the user to annotate the web page directly on the browser.

As per claims 3 and 10, in claim 21, Sidana states "receiving ... and transmitting...." meaning that the process of annotating depends on the cooperation of two different locations (i.e., Redirector 172 and Browser 170). The present invention allows the user to annotate on the user browser.

In column 10, line 63 through column 11, line 1, Sidana states:

The annotation information is stored in the memory of a redirector. Whenever the user asks to view a Web document, the redirector adds HTML corresponding to the annotation information to the HTML for the Web document ... and sends the "augmented HTML" to the browser to be displayed.

Therefore, in Sidana, after the annotating process is completed within the redirector, the augmented HTML will be transmitted to the browser, and the annotated content will not immediately be displayed.

As per claims 5 and 11, Sidana states, column 7, lines 25-27:

Fig. 7 shows a document displayed on the display screen by the browser in accordance with the augmented HTML 180.

Therefore in Sidana, it is clear that element 712 is used for editing or deleting the annotated content which is stored in the redirector and transmitted to the user and displayed on the user browser. The element 712 is previously stored in Fig. 7 web page, not inserted temporarily by the user.

The description in Sidana, Column 11, lines 1-10, Column 7, lines 59-67, and Column 8, lines 1-34, does not mean inserting a hyperlink object to a web page. Please see Sidana, column 6, lines 61-64, which states:

Redirector 172 modifies any URLs found in the unaugmented HTML so that, in the augmented HTML, such URLs point back to the redirector ....

Also see column 8, lines 25-26 of Sidana, which states:

the browser accesses the redirector instead of the document pointed to by the original URL link ....

Any URL link on a cached web page is replaced by the URL of the redirector.

As per claims 6 and 12, Boys states, column 6, lines 34-36:

allow a lecturer to insert text wording into any place on a cached WEB page ....

The statement above means that the lecturer inserts objects to a cached web page. This is similar to the process of inserting objects to a web page by FrontPage. Boys is different from the present invention which allows inserting objects directly to a browser web page.

As stated above, the approach taken by Boys requires the user to install Software 35 to download a cached web page, not edit the content directly on the web page of browser. The present invention allows the user to edit the content on the web page of browser without installing any software.

Therefore, even if Sidana and Boys were combined as suggested by the Examiner, the resultant combination does not suggest: receiving reading records entered by the end user through the reading records function on the web page and instantly displaying the reading records on the web page.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the

patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Sidana or Boys that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Sidana nor Boys disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's claims.

### **Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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